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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/717,716 | 11/21/2003 | Tomohiko Omura | 12049-0014 | 8863 |
| 22902 | 7590 | 08/17/2005 | EXAMINER | |
| CLARK & BRODY 1090 VERNON AVENUE, NW SUITE 250 WASHINGTON, DC 20005 | | | YEE, DEBORAH | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1742 | |

DATE MAILED: 08/17/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/717,716 | OMURA, TOMOHIKO | |
| | Examiner | Art Unit | |
| | Deborah Yee | 1742 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on _____.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-8 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 21 November 2003 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date <u>4-29-05, 11-21-03</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1 to 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese patent 2001-172739 cited by applicant in IDS dated 11-21-03.

3. JP'739 steel alloy examples in Table 1 on page 6 meet the composition recited by claims 1 to 8. Even though prior art does not specifically teach composites comprising an outer shell of carbonitride of Ti and/or Nb surrounding a nucleus of oxysulfide of Al and Ca and having a major axis of not greater than 7 microns in major axis with an appearance frequency of not less than 10 pieces of composites per 0.1mm² as recited by the claims, such would be suggested or expected since composition limitations are met, and process limitations are closely met. Note that similar to the present invention, the machine-English translation of JP'739 in paragraphs 14, 15 and 28 to 31 recognizes that large nonmetallic inclusions such as Ti(Nb,Zr)-C,N system and the inclusion of calcium-aluminum-(Mg)-O need to be restricted in number and size in order to improve stress corrosion cracking (SCC) and pitting corrosion resistance in an oil well sulfide environment. See paragraph 33 wherein nonmetallic inclusions exists in steel with particle size of 20 micrometers or more at 0.1piece/mm². Hence to further limit size of non-metallic inclusions, as done by present invention,

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would be a matter of routine optimization well within the skill of the artisan and productive of no new and unexpected results.

4. The machine-English translation in paragraphs 36 and 37 teaches continuous casting with control temperature cooling such that large size inclusions are restricted in size and number in order to produce steel pipes for oil wells with excellent SCC. Even though prior art does not teach a cooling rate of not more than 500C/min from 1500 to 1000C as recited by the method claims 4,5,7 and 8, such would be expected since similar objective and goal are achieved.

5. Examiner has considered relevant references cited in European Search Report cited 4-29-05. Also unapplied prior art has been cited to further depict the state of the art in low-alloy steels with non-metallic inclusions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on Monday-Friday from 6:00 to 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Deborah Yee
Primary Examiner
Art Unit 1742

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